



Docket No.: SON-2965  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Takashi Furukawa et al.

Application No.: 10/813,215

Confirmation No.: 3882

Filed: March 31, 2004

Art Unit: 2621

For: REPRODUCING DEVICE AND METHOD,  
RECORDING MEDIUM AND PROGRAM

Examiner: H. Q. Dang

**REPLY BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**INTRODUCTORY COMMENTS**

This is a Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed on September 1, 2010.

Regarding any new issue raised in the Reply Brief, if present, U.S. patent practice and procedures set forth within 37 C.F.R. §41.43(a)(1) instructs as follows:

After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

All arguments presented within the Appeal Brief of June 4, 2010 are incorporated herein by reference. Additional arguments are provided hereinbelow.

Among others, the following positions were presented in the Examiner's Answer, each of which will be addressed in turn in this Reply Brief.

**Remarks/Arguments** begin on page 3 of this paper.

**REMARKS****i. U.S. Patent No. 6,009,236 (Mishima)****A. Mishima does not explicitly disclose a calculation.**

Page 23 of the Examiner's Answer readily confirms that Mishima does not explicitly disclose a calculation for the acceleration and deceleration.

But in contradicting this admission, page 7 of the Final Office Action contends the following:

*Mishima et al also disclose wherein, at a transition from said normal playback to said high-speed playback, an acceleration in accordance with time required to read out and decode said low resolution data is calculated so as to perform acceleration at said calculated acceleration (Col 16, lines 60-64 "at the time of the special playback, the data to be accessed decreases so that a smooth special playback can be obtained by gradually decreasing the data amount to be accessed at the time of the special playback").*

In attempting to explain this contradiction, page 30 of the Examiner's Answer provides as follows:

*In response, Examiner respectfully disagrees. In column 16, lines 60-64, Mishima describes a process of acceleration, which involves calculation of amount of data to be accessed or read out (per unit of time that accommodates the specific speed of reproduction, for example, a double speed playback as described in column 23, lines 20-25 or fifteen time speed as described in column 29, lines 45-55). Further, given a unit of time to play back a given amount of data, the high speed playback also involves only the decoding of low resolution data as described in column 20, lines 39-43.*

However, *no acceleration process* is described in Mishima at the cited passages.

For example, Mishima discloses the following at column 16, lines 60-64:

As a consequence, at the time of the special playback, the data to be accessed decreases so that a smooth special playback can be obtained by gradually decreasing the data amount to be accessed at the time of the special playback.

Yet, *nothing* within this passage *refers to "a calculation"*.

Mishima discloses the following at column 23, lines 18-25:

Since the mode is switched over between a mode of decoding and displaying only the I picture and the mode of displaying the I picture and the P picture, the special playback of the I picture and the P picture can be realized at a relatively slow special playback (for example, a double-speed playback) with the result that a fine special playback free from frame jumping can be realized compared with the special playback of only the I picture.

Again, *nothing* within this passage *refers to "a calculation"*.

Mishima discloses the following at column 29, lines 45-55:

Consequently, when the high speed playback speed is increased, after only the data of the area 2 located at the central part of the screen is read the optical head jumps to the front of the subsequent GOP so that only the data in the area 2 that can be read is inputted to the buffer memory 22. In this case, the format decoder 23 decodes only the area 2 of the I picture that can be read. On the other hand, the areas 1 and 3 whose data are not read are masked by the gray data, and a high speed playback picture is outputted. Consequently, in the case where one GOP is set to 15 frames, a 15 times speed special playback picture can be obtained.

**Nothing** within this passage **refers to “a calculation”**.

Mishima discloses the following at column 20, lines 39-43:

At the time of the special playback, a decoding mode is switched over in accordance with the operating state of the device so that a rough picture can be decoded by decoding only the coded data of low resolution.

**Nothing** within this passage **refers to “a calculation”**.

But even if a calculation is present within any of these passages, the Examiner’s Answer fails to show within Mishima:

Claim 18: wherein, at a transition from said high-speed playback to said normal playback, **an acceleration in accordance with time required to read out and decode said main track data is calculated** so as to perform deceleration at a deceleration corresponding to said calculated acceleration.

Claim 23: wherein, at a transition from said normal playback to said high-speed playback, **an acceleration in accordance with time required to read out and decode said low resolution data is calculated** so as to perform acceleration at said calculated acceleration.

Claim 34: **calculating an acceleration in accordance with time required to read out and decode said low resolution data**, said acceleration being calculated at a transition from said normal playback to said high-speed playback.

Claim 45: **calculating an acceleration in accordance with time required to read out and decode said low resolution data**, said acceleration being calculated at a transition from said normal playback to said high-speed playback.

In addition to the above, **no acceleration** is calculated within Mishima.

ii. U.S. Patent No. 7,058,280 (Suzuki)

A. Suzuki fails to disclose a transition from high-speed playback to normal playback.

Page 25 of the Examiner's Answer asserts the following:

*And then, after that, if the user issues an instruction to perform search reproduction mode, the device operates in high speed reproduction mode, a process of switching between normal reproduction mode and search reproduction mode will be executed in accordance to user's instructions during reproduction, and is therefore a transition.*

Although Suzuki may quite possibly disclose *a transition from a high-speed playback to a normal playback*, Suzuki is silent as to the details associated with *a transition from a high-speed playback to a normal playback*.

B. Suzuki fails to disclose a calculation.

Pages 25-26 of the Examiner's Answer assert the following:

*As such, switching between these two reproduction modes requires predetermined processes to be performed by the system involving different calculations or computing on the side of the processor. For example, if going from a high-speed reproduction to normal reproduction, a calculation must be involved (because the task of ordering, rearranging, and determining how many frames should be outputted per a unit of time requires processing as described in the quoted passage of Suzuki) to achieve a deceleration to reproduction at normal speed. In the embodiment described in the underlined text above, Suzuki explicitly illustrates a*

*scenario when a speed of five times higher than normal reproduction speed is performed. Without a calculation as asserted by Appellant, at least the questions of how the system controls a disc controller to read out such a predetermined amount of data per unit of time, how the system controls the decoder to decode such a predetermined number of frames per unit of time, and how the system controls to combine such a predetermined number of frames to be combined into an image screen with such a predetermined number of regions can only be answered by asserting that, "all that can be performed without any means to perform them". And that is an unacceptable answer.*

*Further, as described above, such accelerations and decelerations are calculated per unit of time, as such, it is in accordance with time required to perform the calculated process of transition.*

In response, the Patent and Trademark Office may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. *In re Warner and Warner*, 154 USPQ 173, 178 (C.C.P.A. 1967).

Here, the Office Action appears to resort to speculation, unfounded assumptions or hindsight reconstruction in its attempt to show that *a calculation must be involved if going from a high-speed reproduction to normal reproduction.*

Inherency requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

A patentable invention, within the ambit of 35 U.S.C. §103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969).

As explained within *In re Spormann*, 150 USPQ 449, 452 (CCPA 1966) regarding inherency and obviousness:

*The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.*

However, the Examiner's Answer fails to provide any objective evidence showing that *switching between these two reproduction modes requires predetermined processes to be performed by the system involving different calculations or computing on the side of the processor.*

Note the Decision on Appeal from The Board of Patent Appeals and Interferences in *Ex parte Darolia*, Appeal No. 2009-005819, decided on June 14, 2010.

In reversing the Examiner's rejection under 35 U.S.C. §103, Judge Nagumo explained on pages 7-8 of the Decision in *Ex parte Darolia* that:

*The Examiner has not directed Board to any disclosure in the Rigney Patent indicating a recognition that the decomposition of carbides is known or desirable under the disclosed conditions*".

Similarly, the Examiner's Answer fails to direct the Board to any disclosure within Suzuki for showing that the requisite calculation would have been inherent.

An identification of any objective evidence for showing the presence of a calculation within Suzuki is conspicuously absent from within the Examiner's Answer.

Instead, the rational presented within the Examiner's Answer relies exclusively upon metaphors and allegory.

Thus, Suzuki fails to disclose, teach, or suggest the calculation of *an acceleration in accordance with time required to read out and decode the main track data.*



C. Suzuki fails to disclose that an acceleration in accordance with time required to read out and decode said main track data is calculated so as to perform deceleration at a deceleration corresponding to said calculated acceleration.

Here, Suzuki fails to disclose, teach, or suggest *deceleration being performed at a deceleration corresponding to a calculated acceleration*.

In this regard no correspondence within Suzuki between a calculated acceleration and a deceleration has been identified within the Examiner's Answer.

### iii. Combination of Mishima and Suzuki.

Pages 27-28 of the Examiner's Answer assert the following:

*Examiner respectfully submits that at least Appellant fails to point out where in Suzuki teachings, the data being played back "does not allow obtaining a complete original picture from one picture data item like the B picture" as Mishima characterized his prior art.*

*Secondly, Fig. 3 of Suzuki which is similar to Fig. 7 of Mishima, which is labeled as prior art, is an order of presenting images in normal reproduction mode (see column 6, lines 42-50 of Suzuki). In normal reproduction mode, the order of presenting frames of images in both Mishima and Suzuki must be the same. In other words, given the same stream, in normal reproduction mode, both Mishima and Suzuki must present these images in the same order as shown in the output sequence of Fig. 3 of Suzuki. For example, if a movie has scene 1, scene 2, and scene 3, each of which comprises a plurality of frames having a determined sequence of presentation, in normal reproduction mode, both Suzuki and Mishima must successfully presenting the frames in each scene in the same order, one after another to give the same content. Otherwise, it is not a normal reproduction.*

Here, the Examiner's Answer again concludes that the skilled artisan would have referred to Suzuki for the features that are admittedly absent from within Mishima.

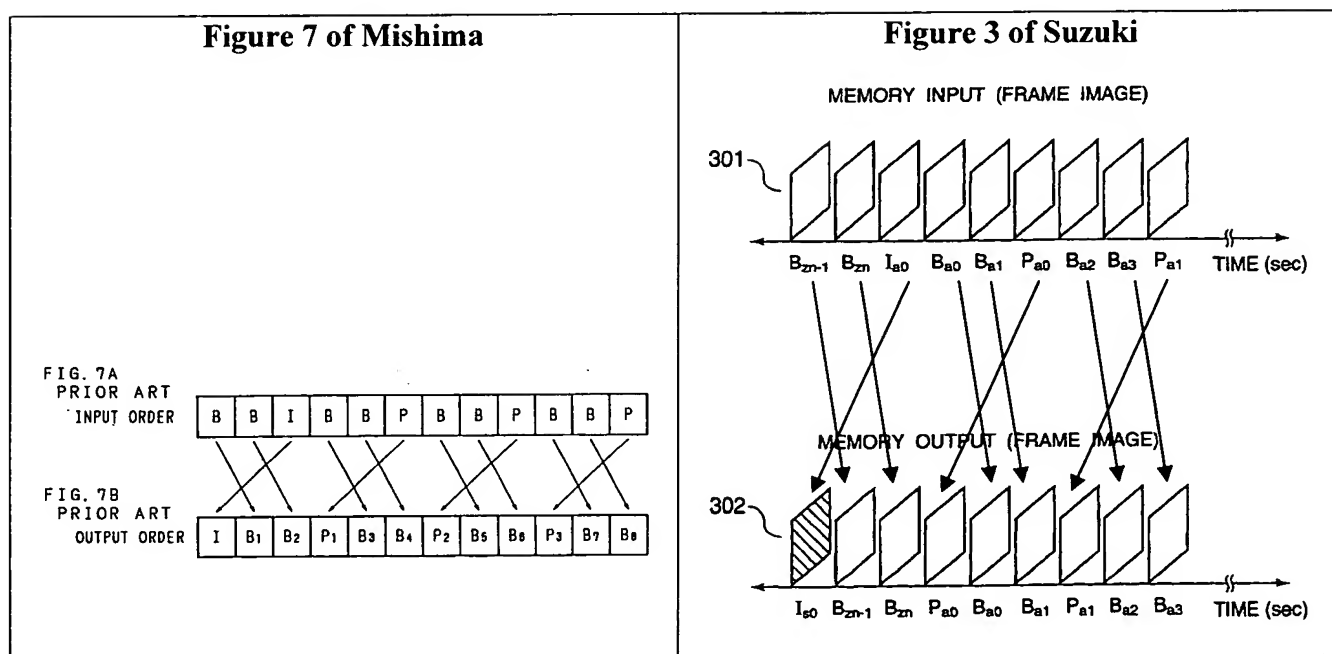
In response, the prosecution history provides evidence of how the PTO and the inventor understood the patent. *Phillips v. AWH Corp.*, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005).

The prosecution history and the patent can be considered together. *Elbex Video Ltd. v. Sensormatic Electronics Corp.*, 85 USPQ2d 1137, 1144 (Fed. Cir. 2007)(Cote, J., dissenting).

Here, note that Item (56) on the cover page of Suzuki identifies Mishima as one of the references cited during the prosecution of Suzuki.

In reviewing the prosecution history of Suzuki, the Office Action of October 31, 2005 mailed in Suzuki and with the Amendment Under 37 CFR 1.121(a) of January 30, 2006 filed in Suzuki both teach away from the combination of Mishima and Suzuki.

Furthermore, Figure 3 of Suzuki as modified for emphasis and Figure 7 of Mishima are provided hereinbelow.



As explained within the Appeal Brief on pages 14-16, Mishima emphasizes the problems associated with Figure 7 of Mishima.

Page 27 of the Examiner's Answer readily agrees that Figure 3 of Suzuki is similar to Figure 7 of Mishima.

By analogy, Mishima expressly emphasizes the problems associated with Figure 3 of Suzuki and proposes alternative solutions to those problems.

Thus, upon comparing Figure 3 of Suzuki with Figure 7 of Mishima, the skilled artisan would not have referred to Suzuki for the features that are admittedly absent from within Mishima, especially when Mishima teaches away from Suzuki.

## CONCLUSION

The prior art of record fails to disclose, teach or suggest all the features of the claimed invention.

For the foregoing reasons, Appellant submits that the rejection of the claims is both technically and legally unsound and should therefore be reversed.

All the claims now pending in the present application are allowable, and the present application is in condition for allowance.

For at least the reasons set forth hereinabove, the rejection of the claimed invention should not be sustained.

Therefore, a reversal of the rejection is respectfully requested.

Dated: October 26, 2010

Respectfully submitted,

By 

Christopher M. Tobin

Registration No.: 40,290

Brian K. Dutton

Registration No.: 47,255

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorney for Applicant